

### **Remarks**

The Office Action and Advisory Action have been reviewed with care and Applicant submits the following remarks/arguments which are believed to place this application in condition for allowance. Applicant appreciates the attention of the Examiner to this patent application.

In the action claims 1-19 and 55-89 are pending. Claims 1-11, 18, 55, 75 and 81-86 stand rejected under 35 USC § 102(b) as anticipated by Stang. Alternatively, claims 1-22, 18, 55, 75, 81-86 and 90 stand rejected under 35 USC §103 as obvious in light of Stang. Claims 12-17, 19, 56-74, 76-80 and 87-90 stand rejected under 35 USC §103 as obvious in light of Stang.

### **§ 102 Rejections**

The Stang reference simply cannot enable one of skill in the art to produce cranberries according to the present invention and therefore the §102 rejection must be withdrawn. The key element to the withdrawal of the rejection stems from the fact that the Examiner has not put forth any indication of how the Stang reference can be found to be enabling.

“To anticipate a claim, a reference must disclose every element of the challenged claim *and* enable one skilled in the art to make the anticipating subject matter.” *PPG Industries, Inc. v. Gaurdian Industries Corp.*, 75 F.3d 1558, 1566, 37 USPQ2d 1618 (Fed. Cir. 1996) (emphasis added). The Examiner’s rejections are based entirely upon guesses and “possible” mathematical distributions to reach the “Mean Fruit Weights” of Table 1 of the Stang reference. The Stang reference, as acknowledged by the Examiner, puts forth contradictory results in Table 1 when the “Mean Fruit Weight” is mathematically compared to the Fruits gathered by weight also shown in Table 1. The written description of the Stang reference gives detailed methodology for the experiments but is silent as to which numbers may be correct. Simply put: how does the Examiner know what the true result of utilization of the method taught in the Stang reference will be? The answer is that the Examiner cannot. Therefore, the Stang reference does not meet the two pronged test for anticipation because, even assuming it does disclose every step (which

Applicant does not believe the reference does), it absolutely fails to disclose if it will actually enable one of skill in the art to reproduce the method of claim 1.

This argument can be thought of in a different manner as well. It is a common axiom of patent law that that which would literally infringe if later anticipates if earlier. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d (Fed. Cir. 1987). Due to the contradictory results acknowledged by the Examiner, there is no possible way that the Examiner can know if practicing the method taught in Stang will result in most of the cranberries grown having a mature mass of less than 0.6 grams. Therefore, practice of the Stang reference may not result in an infringement of claim 1 and due to this unknown, the Examiner, without definitive knowledge of the results, cannot utilize the Stang reference as § 102 art.

The Applicant remains convinced that the Stang reference's errors are in the reporting of the "Mean Weight" as argued in the previous response and therefore does not disclose all the steps of the present invention. However, even if Examiner continues to contend that such results *may* be correct, the inconsistencies in the results make the reference non-enabling since it is unknown if one of skill in the art could utilize the Stang methodology to reach the current invention. It is this lack of enablement that demands that the reference fail as an anticipating reference without further information and the Examiner has failed to put forth any argument to show that the reference does it fact enable.

Alternatively, in relation to claims 3, 5, 6 and 55 the Stang reference does not teach the claimed methods and therefore does not anticipate these claims. Assuming *arguendo* that Table 1 of the Stang reference does disclose most of the berries being less than 0.6 grams those results only come from the method utilized in 1986 for which Table 1 is representative of. The 1986 method teaches: 100ppm concentration with three applications ( 50% or mid-bloom, 100% or full-bloom, and 100% + 7 days or post-bloom).

Claim 3 requires that there only be a single application step to achieve its result and therefore is not anticipated by Stang. Claim 5 requires that application occur when between 60-80% of the plants have bloomed and therefore is not anticipated by Stang. Claim 6 requires

application when about 70% of the plants have bloomed and therefore is not anticipated by Stang. Claim 55 requires that *all* berries have a mature mass of less than 0.75 grams and therefore is not disclosed by Stang since even in the Examiner's hypotheticals you cannot eliminate that some of the berries are above 0.75 grams.

In contrast, Table 3 applies to 1987 results which utilize different application methods but *never* result in a mean berry weight less than 0.7 grams and therefore do not apply to the present invention.

Furthermore, in relation to the §102 rejections of claims 75 and 81-86, Applicant questions how these claims can be rejected under § 102 when the claim from which they depend, claim 72, stands rejected under § 103. Obviously there must be some error since such a result is not possible. Lastly, applicant points out that there is no claim 90.

#### **103 rejection of Claims 1-19 and 55-90**

The Office Action rejected claims 1-19 and 55-90 as being obvious in view of Stang et al. The rejection contends that it would be obvious to one of ordinary skill in the art to further experiment in view of Stang et al. in order to find the specific claimed ranges. Declarations from Jonathan D. Smith, Ph.D. and Donald Wandler which support the nonobviousness and patentability of claims 20-38 were submitted with the response filed August 11, 2003.

*In re O'Farrell*, 7 USPQ2d 1673 (Fed. Cir. 1988), established that the formula for obviousness is "obvious to try with a reasonable expectation of success." As stated in the Smith declaration, experts "failed to or simply did not believe that it would be possible to reach such levels of fruit set," i.e., there was no reasonable expectation of success in achieving the methods of the present invention. The declarations further support nonobviousness in that the introduction of cranberries of the small sizes allowed through the present invention were supported by consumers willing to pay substantially higher prices for them.

Furthermore, the cited prior art does not teach "how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued." *In re Eli Lilly & Co.*, 14

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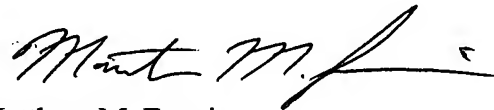
USPQ2d 1741 (Fed. Cir. 1990). "In the absence of such guidance, the reference[] might make the claimed invention obvious to try, but [it does] not make it unpatentable under 35 USC 103." USPTO Board of Patent Appeals and Interferences, *Ex parte Majumder*, Appeal No. 2002-0449, Application No. 09/037,409, Paper No. 20.

**Summary**

In summary, the Stang reference does not enable one of skill in the art to develop the methods of the current invention and therefore cannot be used as an anticipating reference. Secondly, the declarations previously presented in this application present strong evidence of non-obviousness of the current invention that overcomes any prima facie case of obviousness that the examiner has presented.

Applicant believes that all rejections have been traversed by argument and/or declaration and all claims are in proper form for allowance. Early favorable action is earnestly solicited. The Examiner is invited to call the undersigned attorney if that would be helpful in facilitating resolution of any issues which might remain. Please debit Deposit Account 10-0270 for the required fees and notify the undersigned attorney.

Respectfully submitted,




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